

PATENT**Application # 10/664,754****Attorney Docket # 2002P15652US01 (1009-039)****REMARKS**

Applicant respectfully thanks the Examiner for the consideration provided to this application, and respectfully requests reconsideration of this application.

Each of claims 4, 6, 7, 9, 11, and 17 has been amended for at least one reason unrelated to patentability, including at least one of: to explicitly present one or more elements, limitations, phrases, terms and/or words implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claims 1-20 are now pending in this application. Each of claims 1, 19, and 20 is in independent form.

I. The Anticipation Rejections

Each of claims 1-12, and 19-20 was rejected as anticipated under 35 U.S.C. 102(b). In support of the rejection, various portions of U.S. Patent No. 6,282,455 ("Engdahl") were applied. These rejections are respectfully traversed.

A. Legal Standards

To establish a *prima facie* case of express anticipation, the "invention must have been known to the art in the detail of the claim; that is, all of the elements and limitations of the claim must be shown in a single prior art reference, arranged as in the claim". *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); *See also*, MPEP 2131. The single reference must describe the claimed subject matter "with sufficient clarity and detail to establish that the subject matter existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention". *Crown Operations Int'l, LTD v. Solutia Inc.*, 289 F.3d 1367, 1375, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002).

Moreover, the prior art reference must be sufficient to enable one with ordinary skill in the art to

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practice the claimed invention. *In re Borst*, 345 F.2d 851, 855, 145 USPQ 554, 557 (CCPA 1965), *cert. denied*, 382 U.S. 973 (1966); *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354, 65 USPQ2d 1385, 1416 (Fed. Cir. 2003) (“A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled.”)

The USPTO “has the initial duty of supplying the factual basis for its rejection.” *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967).

B. Analysis

Engdahl fails to establish a *prima facie* case of anticipation.

Specifically, each of claims 1, and 19, from one of which each of claims 2-12 ultimately depends, states, *inter alia*, yet the applied portions of Engdahl do not teach, “responsive to a detected collision between a parent node of said hierarchy of said collection and a leaf node of the parent node, automatically **adjusting a position of said parent node**”. Claim 20 states, *inter alia*, yet the applied portions of Engdahl do not teach, “a processor adapted to, responsive to a detected collision between a parent node of said hierarchy of said collection and a leaf node of the parent node, automatically **adjust a position of said parent node**”.

The present Office Action alleges, at least at Page 3, that this claimed subject matter is taught as:

...responsive to a detected collision between a parent node of said hierarchy of said collection and a leaf node of the parent node (‘...is on top of another object...’ col. 8, lines 25-26), automatically adjusting a position of said parent node (‘...parent node connects to the child node’s properties...’ col. 8, lines 29-30).

Yet the present Office Action fails to provide evidence that the applied portion of Engdahl that allegedly states, at col. 8, lines 29-30, “node connects to the child node’s properties” teaches “automatically” adjusting a “position of said parent node”. Instead, regarding the “properties” referenced in col. 8, lines 29-30, Engdahl allegedly states, at col. 8, lines 30-51 (emphasis added):

[f]or example, the meter tool 68 has an input argument accepting a physical quantity output type that may be a physical quantity reflected in data of a property

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associated with another object 64. Placement of the meter tool 68 on a particular stationary object 64 **provides a reading of physical quantity I/O data in quantitative form that is part of the properties of the node of the stationary object 64**. An example stationary object would be a terminal block object 109 providing a visual terminal for electrical values and having a voltage property. As a second example, the communications port object 91 may have **communications data as a property readable by the meter tool 68**. The identification of objects that should have their arguments connected is by parent child relationships of the scene graph 56. **All properties of the nodes, representing data associated with the nodes, may be grouped according to data type** so that such linkages may be established automatically. Thus the meter tool methods indicate the type of data they may accept (e.g., voltage, temperature, logic) and when connected to another node as a child may search for relevant data types and automatically connect to these devices by reading the properties associated with the data types.

The "properties" referenced by the applied portion of Engdahl appear to be related to providing a **"reading of physical quantity I/O data in quantitative form"**, **"communications data"**, or **"data associated with the nodes"**. The present Office Action presents no evidence that any "properties" referenced by the applied portions of Engdahl teach, "automatically" adjusting a "position of said parent node".

For at least this reason, it is respectfully submitted that the rejection of claims 1, 19, and 10 is unsupported by Engdahl and should be withdrawn. Also, the rejection of claims 2-12, each ultimately depending from independent claim, is unsupported by Engdahl and also should be withdrawn.

II. The Obviousness Rejections

Each of claims 13-18 was rejected under 35 U.S.C. 103(a) as being unpatentable over various combinations of U.S. Patent No. 6,282,455 ("Engdahl"), U.S. Patent No. 2004/0021679 ("Chapman"), and/or U.S. Patent No. 5,911,145 ("Arora"). Each of these rejections is respectfully traversed.

PATENT**Application # 10/664,754****Attorney Docket # 2002P15652US01 (1009-039)****A. Legal Standards****1. *Prima Facie* Criteria for an Obviousness Rejection**

Over 40 years ago, in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court established factors regarding the factual inquiry required to establish obviousness. The factors include:

1. determining the scope and contents of the prior art;
2. ascertaining differences between the prior art and the claims at issue;
3. resolving the level of ordinary skill in the pertinent art; and
4. considering objective evidence indicating obviousness or nonobviousness.

The Federal Circuit has applied *Graham*'s required factual inquiry in numerous legal precedents that are binding on the USPTO.

It is recognized that most patentable inventions arise from a combination of old elements and often, each element is found in the prior art. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). The United States Supreme Court clarified the obviousness inquiry criteria in *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007). The KSR Court held:

1. "[t]he question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art";
2. "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art";
3. it is necessary "to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit"; and
4. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" (*quoting In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

In order to establish a *prima facie* case of obviousness, certain criteria must be met. Evidence must be provided that indicates that the combination was obvious to a person with ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007);

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In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The evidence must include an apparent reason, with a rational underpinning, to combine the known elements in the fashion claimed in the patent at issue. *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007). There must be a reasonable expectation of success. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143. In addition, the prior art reference (or references when combined) must teach... all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143.

Moreover, the "Patent Office has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057, *reh'g denied*, 390 U.S. 1000 (1968). "It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis". *Id.*

It is legal error to "substitute[] supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results." See, *In re Ochiai*, 71 F.3d 1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1998); *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

"Once the examiner... carries the burden of making out a *prima facie* case of unpatentability, 'the burden of coming forward with evidence or argument shifts to the applicant.'" *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (quoting *In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

2. All Words in a Claim Must Be Considered

"To establish *prima facie* obviousness..., '[a]ll words in a claim must be considered'". MPEP 2143.03, quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); see also, *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilder*, 429 F.2d 447, 166 USPQ 545, 548 (CCPA 1970); *In re Angstadt*, 537 F.2d 498, 190 USPQ 214, 217 (CCPA 1976); *In re Geerdes*, 491 F.2d 1260, 180 USPQ 789, 791 (CCPA 1974).

3. Next Office Action

If an Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the applied reference will necessarily be factually based

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on an entirely different portion of that reference, and thus will be legally defined as a “new grounds of rejection.” Consequently, any Office Action containing such rejection can not properly be made final. *See, In re Wiechert*, 152 USPQ 247, 251-52 (CCPA 1967) (defining “new ground of rejection” and requiring that “when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference”), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967) (the USPTO “has the initial duty of supplying the factual basis for its rejection”).

B. Analysis**1. Claims 13-18**

As demonstrated, *supra*, claim 1, from which each of claims 13-18 ultimately depends, states, *inter alia*, yet the applied portions of Engdahl do not teach, a “responsive to a detected collision between a parent node of said hierarchy of said collection and a leaf node of the parent node, automatically adjusting a position of said parent node”.

The applied portions of the other applied references fail to cure at least these deficiencies of the applied portions of Engdahl.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

Applicant respectfully notes that the present Office Action fails to evidence the scope and contents of the prior art as required under *Graham*. The present Office Action fails to even identify what “the pertinent art” is. Moreover, the present Office Action fails to evidence the level of ordinary skill in the pertinent art.

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Applicant respectfully traverses the failure of the present Office Action to comply with the requirements of *Graham* and thereby, to provide a *prima facie* rejection under 35 U.S.C. 103. For at least these reasons, Applicant respectfully requests a reconsideration and withdrawal of each rejection of each of claims 13-18.

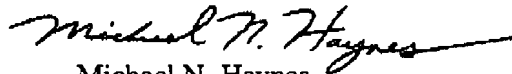
CONCLUSION

It is respectfully submitted that the application is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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